

REMARKS

The present Amendment is in response to the Official Action mailed July 9, 2008. Claims 1, 10, 14, and 16 have been amended, claims 6-8 have been previously canceled, and claims 19-24 are new. Thus, claims 1-5 and 9-24 remain pending in the present case. The following sets forth Applicants' remarks pertaining to the currently pending claims and the outstanding Action.

As an initial matter, Applicants respectfully thank the Examiner for conducting the telephone interview of December 23, 2008 in connection with the present case, and two other related cases that the Examiner is handling. Specifically, in that telephone discussion, the present case and U.S. Patent Application Serial Nos. 10/781,505 and 10/781,506 were discussed. In addition, it was brought to the Examiner's attention that at least one other case in the family of cases relating to the present case includes similarly claimed subject matter (i.e., U.S. Patent Application Serial No. 10/781,504). In an Information Disclosure Statement accompanying the present case, those cases, as well as prior art cited in connection with them and certain other prior art, have been listed. Should the Examiner wish to review any prosecution documents pertaining to any of the related cases, Applicants would be glad to provide copies of same. In the December 23rd telephone discussion, the Examiner indicated, at least initially, that such would not be necessary.

In the December 23rd telephone discussion, the outstanding Action was also discussed in detail. Specifically, Applicants' undersigned counsel provided arguments as to why the insertion plate arrangement of the present invention was very different from that of the cited prior art. Namely, the element referred to by the Examiner as meeting the "insertion plate" limitation of the claims in U.S. Patent Application Publication

No. 2003/0187454 to Gill et al. ("Gill") simply operated in a different fashion than the insertion plate of the present invention. First, the insertion plate of Gill is not removably coupled with an insertion handle (as is acknowledged by the Examiner) and is only capable of being connected to holes in the flange of the intervertebral disc replacement device that are meant to ultimately receive bone screws for fixing the device to the adjacent vertebral bones. This is best shown in Fig. 15B of Gill where locking cam screws (90) are placed through apertures (80) of the insertion tool of Gill, and into apertures (36) and (56) of the intervertebral disc replacement device of that reference. On the other hand, the present invention shows its insertion plate 700 being coupled with mounting screw holes 509, 609 of the intervertebral disc replacement device of the present invention, thereby leaving bone screw holes 508a, 508b, 608a, 608b capable of receiving bone screws while the insertion plate is still coupled to the device. As is more specifically set forth in paragraph [0069] of the originally-filed specification of the present case, this provides the benefit of placing the two components of the intervertebral disc replacement device in a familiar fashion to the surgeon, i.e., similar to that of a spinal plate (an example of which is shown in Figs. 13a-13d). The Examiner agreed that this was indeed a significant difference between the present invention and that of Gill, and indicated that claim amendments that more specifically capture these differences would likely overcome the rejections set forth in the Action.

Turning now to the substance of the Action, the Examiner set forth the following rejections of the previously presented claims:

- Claims 1-5 under 35 U.S.C. § 103(a) as being obvious over the combination of Gill, U.S. Patent

No. 5,599,279 to Slotman et al. ("Slotman"), and U.S. Patent No. 6,991,654 to Foley ("Foley").

- Claim 9 under 35 U.S.C. § 103(a) as being obvious over the combination of Gill, Slotman, Foley, and U.S. Patent Application Publication No. 2003/0093153 to Banick et al. ("Banick").
- Claim 10 under 35 U.S.C. § 103(a) as being obvious over the combination of Gill and Slotman.
- Claims 11-17 under 35 U.S.C. § 103(a) as being obvious over the combination of Gill, Slotman, and U.S. Patent No. 6,235,034 to Bray ("Bray").
- Claim 18 under 35 U.S.C. § 103(a) as being obvious over the combination of Gill, Slotman, Bray, and U.S. Patent No. 6,413,259 to Lyons et al. ("Lyons").

Thus, the Examiner utilized Gill as the primary reference in rejecting each and every one of the previously presented claims. In particular, the Examiner asserted that Gill teaches the insertion plate limitations set forth in independent claims 1 and 10. However, as was discussed in the December 23rd telephone interview, and as is more fully set forth above, the element in Gill that the Examiner utilized as meeting the "insertion plate" limitation of the previously presented claims is very different from the insertion plate of the present invention. Namely, element (76) of Gill simply does not allow for the two components of the intervertebral disc replacement device of that reference to be affixed to the adjacent vertebrae while the plate remains connected with those members.

In the present Amendment, independent claim 1 has been amended to further require the step of "fixing the first member to the first vertebral bone and the second member to the second vertebral bone while the first and second members remain as the

single unit by way of the insertion plate," and independent claim 10 has been amended to further require the step of "fixing the first member to the first vertebral bone and the second member to the second vertebral bone while the first and second members are maintained as the single unit by way of the insertion plate." This step is clearly not possible utilizing the "insertion plate" of Gill, and therefore, even the combinations of references set forth in the Action fail to teach each and every one of the limitations of independent claims 1 and 10, as amended. Therefore, such claims overcome the 35 U.S.C. § 103(a) rejections set forth in the Action.

Although not specifically discussed above, each of the remaining dependent claims also overcome the rejections set forth in the Action based upon their proper dependence from one of independent claims 1 or 10, or an intervening claim. Among these claims are new claims 19-24, which have been added to capture certain method steps not specifically set forth in either of the independent claims. Moreover, any of these dependent claims may, in fact, include subject matter even more clearly not taught by the prior art, and Applicants reserve the right to argue such at a later date, if necessary. Therefore, in light of all of the above, Applicants respectfully request allowance of each and every one of the currently pending claims.

As it is believed that all of the rejections set forth in the Action have been fully met, favorable reconsideration and allowance are earnestly solicited. If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone Applicants' attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

Application No.: 10/781,507

Docket No.: SPINE 3.0-455 CIP CONT VI

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

By 

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